

REMARKS

This Amendment is submitted in response to the Office Action dated March 18, 2004. In the Office Action, the Patent Office finally rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Further, the Patent Office finally rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648) in view of *Walz* (U.S. Patent No. 5,664,725).

By the present Amendment, Applicant amended Claims 1, 13 and 16. Applicant submits that the amendments to the application and the reasons that follow overcome the rejections by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* in view of *Schwan et al.*, Applicant submits that the amendment to Claims 1 and 13 overcomes the rejection under 35 U.S.C. §103(a) and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office alleges:

Petkovsek discloses in Figures 1, 2 and 6, a mailing assembly and a method for preparing a mailpiece comprising a first and second mailing forms (10a and 10b) wherein the forms include a first return postcard (13) integrally formed with a designator section (20, 24A and 26) indicative of a special service (Col. 4, lines 10-14 and 29-31), having an area consisting of a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20), and being distinctly colored (Col. 4, lines 40-41) and contained within the first exterior sides (right of perforated 29a, and left of perforated line 33a) that defines the postcard.

The Patent Office admits that *Petkovsek* does not disclose a designator section having a color corresponding to one of a plurality of special services wherein the color is different for each one of the special services.

Additionally, the Patent Office alleges:

Schwan et al. discloses in Fig. 3, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors. The label can be used for mailing labels in which different colors are activated to designate the method (special services) of shipment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Petkovsek's* label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by *Schwan et al.*

Moreover, the Patent Office alleges:

In regards to Claims 1, 7, 9, and 13, a recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, *Petkovsek's* label is capable of denoting a special service that includes registered mail, certified mail, COD, return receipt for merchandise.

Independent Claim 1, as amended, requires a first designator section contained within first exterior sides that define the first return postcard wherein the designator section has a first area denoting a type of special service for which the assembly is implemented. Further, the first area encircles a tracking area for tracking the mailpiece. Moreover, the first area has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services.

Contrary to the assertion made by the Patent Office, *Petkovsek* merely teaches an integral special service mailing assembly for mailing an article requiring special services which has a return receipt postcard and a label indicative of the special service and a method for using the same. Additionally, *Schwan et al.* merely teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure, combine

to form different colored areas on the sheet. Further, *Schwan et al.* merely teach a business record in which different selected areas may be activated to form colored areas.

Clearly, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a designator section which has a first area denoting a type of special service for which the assembly is implemented wherein the first area encircles a tracking area for tracking the mailpiece and further wherein the first area has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services as required by Claim 1.

Contrary to the assertion of the Patent Office, *Petkovsek* merely teaches that "the return receipt postcard 13 may include a set of instructions 20 for the sender" and that "numeral 26 includes a machine readable article identification number corresponding to the number in the window section 16 of the pre-printed label 12." *Petkovsek* teaches that the set of instructions 20 and the numeral 26 (as shown in FIGS. 1-6) are not located in a first area of the mailing assembly. Further, the Patent Office admits that *Petkovsek* does not disclose a designator section having a color corresponding to one of a

plurality of special services wherein the color is different for each one of the special services. Moreover, nowhere does *Schwan et al.* teach or suggest a first area which encircles a tracking area for tracking the mailpiece and further wherein the first area has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services as required by Claim 1. Therefore, nowhere does *Petkovsek* or *Schwan et al.* teach or suggest a designator section which has a first area denoting a type of special service for which the assembly is implemented wherein the first area encircles a tracking area for tracking the mailpiece and further wherein the first area has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services as required by Claim 1.

Independent Claim 13, as amended, requires the step of providing a first return postcard which is integrally formed with a first special service designation section. Further, the first special service designation section has a first area for receiving instructions regarding the delivery and a type of special service. Moreover, the first area encircles an

identifying number of the mailpiece by the special service and further wherein the first special designation section is completely within exterior sides that define the first postcard.

Neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a first special service designation section which has a first area for receiving instructions regarding the delivery and a type of special service wherein the first area encircles an identifying number of the mailpiece by the special service and further wherein the first special designation section is completely within exterior sides that define the first postcard as required by Claim 13.

Contrary to the assertion of the Patent Office, *Petkovsek* merely teaches a return receipt postcard having a set of instructions for the sender, addressee section and a document control number bar code.

Petkovsek actually teaches away from a first area which encircles an identifying number of the mailpiece by the special service of the present invention. *Petkovsek* actually teaches that "the pre-printed label 12 includes a special service indicator 15 and a window section 16 in which an article identification number can be printed." The special service indicator 15 of *Petkovsek* does not encircle the numeral 26 as specifically defined in Claim 13. Therefore,

the special service indicator 15, the set of instructions 20 and the number 26 of *Petkovsek* teach away from the first area as required by Claim 13.

Moreover, with respect to the rejection of Claims 1 and 13 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Petkovsek* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by

Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* and *Schwan et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Petkovsek* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing, the rejection of Claims 1-15 under 35 U.S.C. §103, in view of *Petkovsek* and further in view of *Schwan et al.* has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the assertion of the Patent Office that the label of *Petkovsek* is capable of denoting a special service that includes registered mail, certified mail, COD, return receipt for merchandise, Applicant asserts that the special service mailing assembly and the method as specifically defined in Claims 1 and 13, respectively, have novel structural differences and critical steps, respectively, and are patentably distinct from the label of *Petkovsek*. Further, the label of *Petkovsek* does not have a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for

each one of the plurality of special services as required by Claim 1. Still further, the label of *Petkovsek* does not have a first designator section defined by a first area which includes a second area denoting a type of special service for which the assembly is implemented and a tracking area for tracking the mailpiece as required by Claim 1. Moreover, the label of *Petkovsek* does not have the step of providing a first special service designation section defined by a first area which includes a second area for receiving instructions regarding the delivery, a type of special service and an identifying number of the mailpiece by the special service as required by Claim 13. Therefore, the special service mailing assembly and method as defined in Claims 1 and 13, respectively, have novel structural differences and critical steps, respectively, and are patentably distinct from the label of *Petkovsek*. Notice to that effect is requested.

With respect to the assertion of the Patent Office that it would have been obvious to program the bar coded area of *Petkovsek* to receive or transmit instructions regarding the delivery of the mailpiece by a special service, Applicant asserts that the method for preparing a mailpiece for delivery by a special service as specifically defined in Claim 13 is patentably distinct from the method of *Petkovsek*. Further,

Petkovsek does not teach the first special service designation section which has a first area for receiving instructions regarding the delivery and a type of special service wherein the first area encircles an identifying number of the mailpiece by the special service as required by Claim 13. Therefore, the method for preparing a mailpiece for delivery by a special service as defined in Claim 13 is patentably distinct from *Petkovsek*. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 under U.S.C. §103(a) as being unpatentable over *Petkovsek* in view of *Walz*, Applicant submits that the amendment to Claim 16 overcomes the rejection and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office alleges:

Petkovsek discloses in Fig. 1, 2 and 6, a first return postcard (13) integrally formed with a designator section (20, 24A, and 26) indicative of a special service of registered mail, COD, or return receipt (Col. 4, lines 10-14 and 29-31) having an area consisting of a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20), and contained within the first exterior sides (right of perforated line 29a, and left of perforated line 33a) that defines the postcard.

However, *Petkovsek* does not disclose a first and a second backing strip received over the adhesive on the backside of the first and the second anchor portion.

Independent Claim 16, as amended, requires a mailing assembly having a first designator section indicative of a type of special mail delivery service wherein the first designator section is contained within exterior sides of the first return postcard. Further, the first designator section identifies the type of the special mail delivery service as one of registered mail, certified mail, COD, insured mail and return receipt for merchandise. Moreover, instructions regarding the delivery of the mailpiece are juxtaposed with the first designator section.

Contrary to the assertions of the Patent Office, *Walz* merely teaches a multi-part mailing form for use by businesses in mailing items to various customers or clients and in keeping records of such mailings and is particularly related to forms for use in certain specific types of mailing, such as certified and registered mail procedures.

Neither *Petkovsek* nor *Walz*, taken singly or in combination, teach or suggest a first designator section indicative of a type of special mail delivery service wherein the first designator section is contained within exterior sides of the first return postcard wherein the first designator section identifies the type of the special mail delivery service as one of registered mail, certified mail, COD, insured mail and return receipt for merchandise and further wherein

instructions regarding the delivery of the mailpiece are juxtaposed with the first designator section as required by Claim 16.

Petkovsek actually teaches away from the first designator section indicative wherein instructions regarding the delivery of the mailpiece are juxtaposed with the first designator section of the present invention. The special service indicator 15 and the set of instructions 20 of *Petkovsek* are not juxtaposed as specifically claimed in Claim 16. Therefore, the special service indicator 15, the set of instructions 20 and the number 26 of *Petkovsek* teaches away from the first designator section area and instructions as required by Claim 16.

Moreover, with respect to the rejection of Claims 16-20 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Petkovsek* with *Walz* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* and *Walz* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* with *Walz* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 16-20 under 35 U.S.C. §103(a) as obvious over *Petkovsek* in view of *Walz* has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-12 depend from independent Claim 1; Claims 14 and 15 depend from independent Claim 13; and Claims 17-20 depend from independent Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's mailing assembly and method, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to

issue.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 17, 2004.

Brian M. Mattson (Reg. No. 35,018)